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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,191	01/23/2004	James Charles Dunbar	CM2596MC	8065

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THE PROCTER & GAMBLE COMPANY
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EXAMINER

ELHILO, EISA B

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 10/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/764,191

Applicant(s)

DUNBAR ET AL.

Examiner

Eisa B Elhilo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/8/2004</u> | 6) <input type="checkbox"/> Other: _____ |

Claims 1-17 are pending in this application.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 12-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 12, 13 and 14 provides for the use of composition and the use of a developer, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 12, 13 and 14 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pratt et al. (WO 98/52519) in view of Audousset et al. (US' 5,578,087).

Pratt et al. (WO' 519) teaches a hair coloring composition comprising a developer of 2,6-dichloropara-aminophenol which capable of undergoing only a single electrophilic attack reaction as claimed in claims 1-4 (see page 25, line 3) and couplers of N,N-dimethyl acetoactamide and diethyl acetoacetamide that read on the claimed formula (I) as claimed in claim 10 (see page 15, lines 10-12), wherein the coupler is selected from the compound of a formula (c), which is similar to the coupler of the claimed formula (IV), when the reference's formula (c), have an active and non active leaving groups as claimed in claim 11 (see page 5, formula (c)), a coupler selected form the group consisting of phenols having an active leaving group in the para position relative to the hydroxyl group and meta-disubstituted benzene compound of 3-aminophenol as claimed in claims 8 and 9 (see page 10 formula IV and line 21). Pratt et al. (WO' 519) also teaches a method for coloring hair comprising applying to the hair the composition as described above and wherein the reference's method is similar to claimed methods as claimed in claims 15-16 (see page 73, claim 21). Pratt et al. (WO' 519) further teaches a hair coloring kit comprising the coloring composition as described above and wherein the reference's kit is similar to claimed kit as claimed in claim 17 (see page 72, claim 20).

Although, Pratt et al. (WO' 519) teaches hair coloring composition, methods and kits which use developers selected from amino aromatic systems capable of being oxidized and thereafter undergoing a single nucleophilic attack reaction and couplers as claimed in combination with oxidants, wherein the couplers encompass the couplers of the claimed formulae (II) and (IV), the patentee differs from the applicant in that Pratt et al. (WO' 519) does

not teach or disclose a composition comprising developers selected from amino aromatic systems capable of being oxidized and thereafter undergoing at least two electrophilic attack reactions as claimed.

Audousset et al. (US' 087) teaches in analogous art of hair coloring formulation, a composition comprising oxidation dye precursor (developer) of para-phenylenediamine as a developer of amino aromatic system capable of being oxidized as thereafter undergoing at least two electrophilic attack reactions or undergoing self-coupling as claimed in claims 5-7 (see col. 3, line 12).

Therefore, in view of the teaching of the secondary reference, one having ordinary skill in the art at the time the invention was made would have been motivated to modify the composition of the primary reference of Pratt et al. (WO' 519) by incorporating the developer of para-phenylenediamine as taught by Audousset et al. (US' 087) to make such a coloring composition with the reasonable expectation of success. Such a modification would be obvious because the primary reference of Pratt et al. (WO' 519) suggests the use of substituted para-phenylenediamine compounds as the developers that undergoing only single electrophilic attack reaction in the hair coloring composition (see page 24, the structural formulae). The secondary reference of Audousset et al. (US' 087) clearly teaches that the developers of para-phenylenediamine (unsubstituted amine compound) which is capable of undergoing at least two electrophilic reactions and N,N-bis (β -hydroxyethyl) para-phenylenediamine (substituted amine compound) which is capable of undergoing only electrophilic attack reaction are both applicable and can be used in the hair coloring composition (see col. 3, lines 13-23), and, thus, a person of the ordinary skill in the art would be motivated to incorporate the para-phenylenediamine that

undergoing at least two electrophilic reactions as taught by Audousset et al., in the composition of Pratt et al., with the reasonable expectation of achieving a performance coloring composition and would expect that the use of para-phenylenediamine as taught by Audousset would be similarly useful and applicable to the analogous composition taught Pratt et al.

With respect to claims 12-14, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply such a composition for improving the root – to-tip evenness given by a hair coloring composition because the combined references teach and disclose compositions having similar coloring ingredients to the claimed composition, and, a person of the ordinary skill in the art would expect such a composition to have similar properties and similar effect on hair and no matter if the hair is previously been colored or not, absent unexpected results.

Further, applicant has not shown on record the criticality of using the claimed combination of at least one developer that undergoing only a single electrophilic attack reaction and at least one developer that undergoing at least two electrophilic attack reactions with at least one of the claimed couplers over the composition of the prior art.

Conclusion

4 The remaining references listed on from 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the rejection above. Further, the prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (WO 98/52520), (WO 98/52521), (WO 98/52522), (WO 98/52523) and (US 3,561,912).

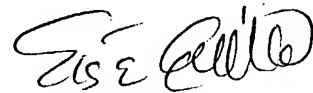
Any inquiry concerning this communication or earlier communications from the

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examiner should be directed to Eisa B Elhilo whose telephone number is (571) 272-1315. The examiner can normally be reached on M - F (8:00 -5:30) with alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eisa Elhilo
Patent Examiner
Art Unit 1751

October2, 2004